

Docket No. 010110

Serial No. 10/043,695

REMARKS

Claims 1-21 are pending in the application.

Claims 1-21 are rejected under 35 USC 102(a) as being unpatentable by La Medica, Jr, et al (US Patent No. 6,625,451) ("La Medica"). Applicant respectfully traverses the rejection.

To anticipate a claim, the reference must teach every aspect of the claimed invention either explicitly or implicitly. (MPEP 706.02) Each independent claim 1, 12, and 17 recites, among other things, "maintaining a list of unusable wireless communication systems" and an "avoidance criterion" associated with each entry in the list. Applicant submits that the cited reference does not teach or suggest the combination defined by each independent claim, particularly the quoted limitations.

Instead, La Medica teaches, with reference to FIG. 6:

"The station 3 also stores the SID of its home system in its NAM memory location and the preferred roaming list (PRL) of SIDs and related acquisition information, to enable the station to select the home system and the preferred systems. The executable code together with the data stored in the NAM and the PRL are software products used in the operation of the mobile station 3.

In accord with the invention, the system selection methodology steers the operation of the handset 3 to the selection of the home system 20 first and then to the best 'preferred' system as identified by SID in the PRL list. However, the system select feature programming of the station 3 also enables the customer to set the station 3 to one or more alternate modes that allow selection of other systems in the event that the home system is unavailable and no system on the PRL list is available.

In the preferred embodiment, the user interface of the station 3 allows the customer to set the station into four system select modes. The display 39 will show a menu of these possible selection mode settings, and the customer selects the desired mode setting from those shown by operation of the keypad 37. The four settings are Home Only, PRL Only, PRL Preferred, and PRL-Non Preferred. The PRL-Non Preferred setting is potentially the

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most costly, and therefore this setting is available only on a limited basis after selection thereof, for example for a short time period (e.g. five minutes) after selection or for one call following the selection. When selected, the station 3 will remain set in the other system selection modes until set to a different mode by some positive action by the customer." (col. 16, line 49 to col. 17, line 11) (emphasis added)

La Medica teaching: "the system select feature programming of the station 3 also enables the customer to set the station 3 to one or more alternate modes that allow selection of other systems in the event that the home system is unavailable and no system on the PRL list is available" is not the same as the independently claimed limitation of "maintaining a list of unusable wireless communication systems" and an "avoidance criterion" associated with each entry in the list.

La Medica also fails to teach the limitations claimed in dependent claims 5-10, 14-16, and 19-21.

Nevertheless, the Applicant amends independent claims 1, 12, and 17 to improve the clarity of claims 1, 12, and 17. Support for the present amendment may be found in the present specification, for example, on page 7, par. 24, and in FIG. 4. Although the Applicant submits that La Medica does not teach or suggest the limitations in independent claims 1, 12, and 17 before this amendment, the examiner may appreciate the improved clarity of presently amended independent claims 1, 12, and 11 when considered in light of the teachings of La Medica.

The Applicants also amends dependent claims 3-6, 9-11, 13, 14, 18, 19, and 21 to provide for proper antecedent basis.

Accordingly, the rejection of the claims under 35 USC 102(a) should be withdrawn in the next Office Action. If this rejection is maintained in the next Office Action, Applicant respectfully requests pinpoint citations to columns and line numbers in the reference for the teachings corresponding to each limitation in each claim.

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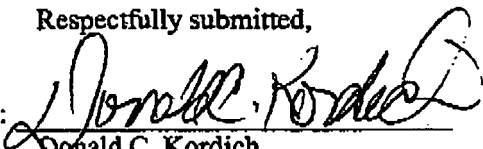
In view of the foregoing, Applicant submits that all pending claims are in condition for allowance. Applicant respectfully requests the reconsideration and reexamination of this application and the timely allowance of the pending claims. Should any issues remain unresolved, the Examiner is encouraged to telephone the undersigned at the number provided below.

If there are any other fees due in connection with the filing of the response, please charge the fees to our Deposit Account No. 17-0026. If a fee is required for an extension of time under 37 CFR 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Applicants therefore respectfully request that a timely Notice of Allowance be issued in this case.

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QUALCOMM Incorporated
5775 Morehouse Drive
San Diego, California 92121-2779
Telephone: (858) 658-5928
Facsimile: (858) 658-2502

Respectfully submitted,
By: 
Donald C. Kordich
Attorney for Applicant
Registration No. 38,213